

REMARKS

Applicants wish to thank Examiner Webhe for the courtesies that she extended to applicants' representative, Matthew Mulkeen, during their telephone conversation on or about October 1, 2003. In that conversation, the Examiner acknowledged that the Office Action of September 9, 2003 had been issued without the Examiner reviewing the Preliminary Remarks and eight attached references that applicants had timely filed on June 19, 2003. The Examiner explained that while the Preliminary Remarks and eight attached references were received by the Office, they were only stored electronically and the actual paper copies were never matched with the file wrapper. When the Examiner issued the Office Action, she had done so without checking the electronic file system. The Examiner also stated that any subsequent Office Action will not be a final action.

Applicants attach hereto the June 19, 2003 date-stamped receipt postcard for the Preliminary Remarks with the attached references. For the Examiner's convenience applicants have resubmitted the eight references with an IDS. Applicants reproduce below a copy of the Preliminary Remarks filed on June 19, 2003.

The Examiner has previously stated that the claims are only enabled for administering the vector into the tumor. Applicants urge reconsideration on the grounds that *in vivo* models have demonstrated that the herpes simplex virus can effectively target a tumor when the virus is not administered directly or locally to the tumor. The non-local targeting of tumors by herpes simplex virus has been well established. Moreover, the degree of experimentation, if any, that one of skill in the art would have needed to practice the present invention, would have simply involved injecting the HSV vector into various locations in a model to determine its efficacy. A claim is enabled even if routine experimentation is required to practice the invention. Lack of enablement is only found when the degree of experimentation is undue.

Applicants have attached hereto references evidencing the effectiveness of the HSV vector when it is not administered directly into a tumor but by systemic delivery. For example, Kooby describes effective delivery of G207, a type of HSV, by both direct tumor injection and regional vascular infusion. (Exhibit 1, abstract and p. 1327). Walker intravenously administered G207 by the tail vein and demonstrated "tumor growth inhibition, regression and eradication of distant prostrate cancers. (Exhibit 2, p. 2239 and 2241). Oyama demonstrated that intravenous injections into the tail of G207 inhibited tumor growth of bladder cancer. (Exhibit 3, abstract and p. 1685). Carew demonstrated the effectiveness of G207 via regional perfusion. (Exhibit 4, p. 1599). For mice that had pre-existing immunity to HSV, while Delman did find that route of viral administration did influence therapy, intravenous delivery did produce some detectable attenuation. (Exhibit, 5, abstract).

Moreover, one of skill in the art could have practiced intraperitoneal, intravesical or intrapleural administration of present invention. Bennett states that peritoneal delivery of G207 effectively kills tumor cells. (Exhibit 6, abstract). Cozzi effectively intravesically treated bladder cancer with both G207 and NV1020. (Exhibit 7, abstract). And, finally, Ebright demonstrated successful intrapleural administration of NV1020. (Exhibit 8, abstract.)

These references effectively demonstrated that the present invention was enabled from more than direct injection to the tumor. Therefore, withdrawal of the present rejection for lack of enablement is respectfully requested.

In view of the above remarks and amendments previously submitted, it is respectfully submitted that this application is in condition for allowance. Early notice to that effect is earnestly solicited. If the Examiner believes that an interview would advance prosecution of the application, she is invited to contact the undersigned by telephone.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date: December 4, 2003

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5300
Facsimile: (202) 672-5399



Matthew E. Mulkeen
Registration No. 44,250